

ESTTA Tracking number: **ESTTA662263**

Filing date: **03/20/2015**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Notice of Opposition

Notice is hereby given that the following party opposes registration of the indicated application.

Opposer Information

Name	Thomas Bannister		
Entity	Individual	Citizenship	UNITED KINGDOM
Address	12 West 18th Street Suite 4E New York, NY 10011 UNITED STATES		

Attorney information	Benjamin Orifici 222 Sackett Street Suite 4R New York, NY 11231 UNITED STATES orifici@gmail.com Phone:9175736411
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Applicant Information

Application No	86423012	Publication date	03/17/2015
Opposition Filing Date	03/20/2015	Opposition Period Ends	04/16/2015
Applicant	Sirius XM Radio Inc. 1221 Avenue of the Americas, 36th Floor New York, NY 10020 UNITED STATES		

Goods/Services Affected by Opposition

Class 038. First Use: 0 First Use In Commerce: 0 All goods and services in the class are opposed, namely: Subscription-based radio broadcasting services

Grounds for Opposition

Priority and likelihood of confusion	Trademark Act section 2(d)
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Mark Cited by Opposer as Basis for Opposition

U.S. Registration No.	3961047	Application Date	07/25/2010
Registration Date	05/17/2011	Foreign Priority Date	NONE
Word Mark	SXM		

Design Mark	
Description of Mark	NONE
Goods/Services	Class 041. First use: First Use: 2008/09/22 First Use In Commerce: 2008/09/22 Entertainment video or audio-visual media production services for motion pictures, television and Internet

Attachments	85092353#TMSN.png(bytes) Notice of Opposition vs. Sirius SXM Design Mark.pdf(31863 bytes)
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Certificate of Service

The undersigned hereby certifies that a copy of this paper has been served upon all parties, at their address record by First Class Mail on this date.

Signature	/BTO/
Name	Benjamin Orifici
Date	03/20/2015

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

_____)	
)	
THOMAS BANNISTER,)	
CEO of SXM CORPORATION)	
Opposer,)	Opposition No. _____
)	
vs.)	<i>In the matter of:</i>
)	
SIRIUS XM RADIO INC.)	Application Serial No. 86423012
Applicant.)	Published March 17, 2015
)	Mark:
)	SXM
_____)	

NOTICE OF OPPOSITION

In the matter of the application for registration of the mark SXM for "subscription based radio broadcasting services" in International Class 38, filed October 14, 2014, by Sirius XM Radio Inc. ("Applicant"), assigned Serial No. 86423012, and published for opposition in the Official Gazette of March 17, 2015, THOMAS BANNISTER, CEO of SXM CORPORATION, ("Opposer") believes that his company would be damaged by such registration, and hereby opposes the registration of Applicant's mark pursuant to 15 USC §1063 and 37 CFR §2.104.

As grounds of opposition, it is alleged that:

1. Opposer Thomas Bannister ("Opposer") is a resident of the United States and a citizen of the United Kingdom with a principal place of business at 12 West 18th Street Suite 4E, New York, NY10011.

2. Furthermore, SXM Corporation is a United States corporation with a principal place of business at Sunset Gower Studios, 1438 N. Gower St. Box 83, Los Angeles, CA 90028.

3. Opposer, since at least September 2008 has been, and is now using the mark SXM in connection with "entertainment video or audio-visual media production services for motion pictures, television and Internet." ("Opposer's Mark")

4. Opposer is the owner of the trademark Registration Number 3961047 for the standard character mark SXM. This registration is on the Principal Register.

5. Applicant filed to register the proposed mark SXM, Serial Number 86423012, for use in connection with "subscription based radio broadcasting services" on October 14, 2014, claiming a 1B intent to use basis. ("Applicant's Mark")

6. Opposer's use of Opposer's Mark has been valid and continuous since at least September 2008 and has not been abandoned. Opposer's Mark is symbolic of extensive good will and consumer recognition.

7. As a result of the substantial amounts of time and effort in advertising and promotion, Opposer has developed an exceedingly valuable goodwill in respect to Opposer's Mark.

8. Applicant's Mark and Opposer's Mark are very similar in sound, appearance and meaning.

9. Applicant's services and Opposer's services are very similar and related.

10. On information and belief, Opposer alleges that the services of Opposer and Applicant are offered or to be offered to similar, if not identical, channels of commerce and to similar, if not identical, customers.

11. Applicant's use of and application to register SXM is without the consent or permission of Opposer.

12. Applicant's Mark and Opposer's Mark are likely to be confused.

13. On information and belief, Opposer's first use of Opposer's Mark precedes Applicant's first use of Applicant's Mark in commerce.

14. Furthermore, on information and belief, Opposer's first use of Opposer's Mark precedes the filing of Applicant's application to register Applicant's Mark in the United States Patent and Trademark Office.

15. As a result of confusing similarity between Opposer's Mark and Applicant's Mark and because the services of Applicant and Opposer are very similar, are in similar channels of commerce, and are directed to similar customers, registration of the proposed mark SXM in connection with Applicant's services is likely to deceive consumers as to the source or sponsorship of such services, to cause confusion, to cause mistake, and/or to deceive.

16. Consumers familiar with Opposer's Mark are likely to mistakenly believe that Applicant's services are sponsored, authorized, associated with or otherwise approved by Opposer because the proposed mark closely resembles Opposer's Mark. This confusion will undermine the substantial sums of money that Opposer has invested as well as Opposer's enormous effort in promoting, marketing, distributing and selling its services in conjunction with Opposer's Mark.

This confusion is likely to result in a substantial loss of revenue to Opposer and damage Opposer's brand and reputation.

17. Applicant's use of the Applicant's Mark does or is likely to falsely suggest a relationship between Applicant's services and Opposer's. Such use of SXM is likely to cause confusion, mistake or deception with respect to the source or sponsorship of Applicant's services. Such use is likely to cause consumers who would be confused by the use of the proposed mark into believing that the Opposer is the source of Applicant's services, resulting in ill-gotten gains by Applicant. Applicant's use of the proposed mark is therefore likely to result in Applicant's trading off and benefitting from the goodwill associated with Opposer's, resulting in ill-gotten gains by Applicant.

18. Opposer is likely to be damaged by registration of Applicant's mark in that the prima facie effect of registration of Applicant's mark would tend to impair Opposer's right to use the wording in Applicant's mark.

19. For the foregoing reasons, the registration sought by Applicant is contrary to the provisions of the Lanham Act, and Opposer would be damaged thereby.

WHEREFORE, Opposer prays that the application for registration of the mark SXM, Serial Number 86423012, be refused and that this Opposition be sustained in favor of Opposer.

The fee required by Sect. 2.6(a)(17) is enclosed herewith.

Opposer hereby appoints Benjamin T. Orifici, member of the Bar of the State of New York, to act as attorney in the matter of the opposition identified above, to prosecute said opposition, to transact all business in the Patent and Trademark Office, and in the United States courts connected

Mark: SXM
Serial No: 86423012
Published March 17, 2015

with the opposition, to sign his name to all papers which are hereinafter to be filed in connection therewith, and to receive all communications relating to the same.

Respectfully submitted for Opposer,

Dated: March 20, 2015

By: _____
Benjamin T. Orifici, Esq.
Attorney for Opposer

222 Sackett Street, Suite 4R
New York, New York 11231

Phone: 917.573.6411
Email: orifici@gmail.com

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SIRIUS XM RADIO INC.)	Application Serial Nos. 86423012
Applicant.)	Published March 17, 2015
)	Mark:
)	SXM
_____)	

CERTIFICATE OF SERVICE

I herby certify that a true and copy of the forgoing Notice of Opposition has been served on the following by mailing said copy on March 20, 2015, via Certified First Class Mail, postage prepaid, to Applicant at it correspondence address of record.

Erica D. Klein, Esq.
Kramer Levin LLP
1177 Avenue of the Americas
New York, New York 10036

By: _____
Benjamin T. Orifici, Esq.